

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85732059
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has refused registration and issued a final rejection under Trademark Act Section 2(d), 15 USC §1052(d), claiming that Applicant's Mark A&M WOLVERINE ASSURANCE COMPANY for various "captive insurance services" in Class 36 so resembles the mark in US Trademark Registration No. 3239010 for the mark WOLVERINE INVESTMENTS in financial and investment services in Class 36, namely, "financial investment in the field of securities; financial management; financial portfolio management; financial risk management; financial services in the nature of an investment security; investment advice; investment consultation; investment management; management of portfolios comprising securities" that it is likely to cause confusion, or to cause mistake, or to deceive. For the reasons set forth below, Applicant respectfully requests reconsideration of the Examiner's finding that confusion is likely since the Examining Attorney has incorrectly ignored/applied incorrect weight to Applicant's rebuttal evidence showing it is well known and recognized the cited mark "WOLVERINE" is weak and not entitled to a broad scope of protection in the insurance and/or financial services field. See McCarthy on Trademarks and Unfair Competition §11.85 (Rev. 2013); In re Lucky Co., 209 USPQ 422 (evidence of third party use shows that the average purchaser has been so conditioned by the large number of users of similar marks that he will notice slight differences so that confusion in trade is not likely to arise from the contemporaneous use").</p> <p>The Examining Attorney has failed to adequately consider Applicant's internet printout when accessing the strength of the cited mark. Evidence of third-party use falls under the sixth <i>du Pont</i> factor—the</p>	

“number and nature of similar marks in use on similar goods.” *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Applicant contends that WOLVERINE is a very weak mark when considered in the light of the numerous third-party uses of similar marks on similar services and, therefore, registrant’s mark deserves only a limited scope of protection.

Applicant also made of record eleven third-party internet web page printouts showing the use of WOLVERINE on a variety of insurance and/or financial services field. A copy of the search results from the finra.org website previously submitted as Exhibit B to the Office Action response dated September 25, 2013 are repeated below:

Legal Name (CRD/IARD#) Summary Information	Other Names	SEC Number
CREO GLOBAL CAPITAL LLC (159771) View Summary: ▪ Investment Adviser Firm	WOLVERINE GLOBAL CAPITAL LLC	
WHB WOLVERINE ASSET MANAGEMENT INC (106020) View Summary: ▪ Investment Adviser Firm	WOLVERINE INVESTMENTS	
WOLVERINE ASSET MANAGEMENT, LLC (138907) View Summary: ▪ Investment Adviser Firm		801-72458
WOLVERINE CAPITAL PARTNERS LLC (141134) View Summary: ▪ Investment Adviser Firm (IA - Inactive)		
WOLVERINE PARTNERS, LLC (144068) View Summary: ▪ Investment Adviser Firm	MUTUALDECISION.COM	

(IA - Inactive)

**WOLVERINE WEALTH ADVISORY SERVICES
INC. (146564)**

View Summary:

- [Investment Adviser Firm](#)

In addition, Applicant has also previously submitted as Exhibit D to the Office Action response dated September 25, 2013 co-existence of the registered mark with other “financial services” firms using the names: Wolverine Asset Management (2 users), Wolverine Capital Partners, Wolverine Partners, Wolverine Venture Fund, Wolverine Bank, Wolverine Financial, Wolverine Mutual, etc. Such evidence shows that members of the purchasing public in the insurance/financial services fields are surrounded by a plethora of service offering all using the weak term “Wolverine” and that, consequently, by any measure of evaluation, the cited mark is a weak mark whose scope has been seriously eroded.” Such evidence clearly shows that consumers of these services are able to distinguish the source of these services each containing the weak term “Wolverine” and that said term would not be exclusively associated with insurance and/or financial service from the registrant. See In re Broadway Chicken, Inc., 38 USPQ2d 1559, 1565-66 (TTAB 1996). (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field”); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (“The record shows that a large number of marks embodying the words ‘bed and breakfast’ are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words ‘bed and breakfast’”).

In light of the above analysis, Applicant respectfully again submits that no likelihood of confusion exists between its Mark and the Cited Mark because: (1) the marks are different in their entireties, (2) the public and the marketplace have already determined that there is no likelihood of confusion in multiple registered investment advisors using the term WOLVERINE (including Registrant) in combination with descriptive terms offering identical services, (3) the services identified by the respective marks serve entirely different purposes and functions, (4) the consumers of the parties' services are sophisticated and/or are likely to exercise care when making the decision to purchase the parties' services, (5) the services of the parties are provided through different channels of trade, (6) the Cited Mark is not famous or well known but highly diluted in the registered investment advisor sector of the broad financial services field entitling it to a narrow scope of protection; (7) the cited mark is weak per the evidence submitted and not entitled to the broad scope of protection in the field of use. For the reasons discussed and the authorities relied upon herein, Applicant respectfully requests that the Examining Attorney reconsider the proffered arguments and evidence and approve Applicant's mark for registration.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS

036

DESCRIPTION

captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; captive insurance consulting and services; design, management and auditing of captive insurance programs

FILING BASIS

Section 1(b)

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS

036

TRACKED TEXT DESCRIPTION

captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; ~~captive insurance consulting and services;~~ captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services and market reviews; ~~design, management and auditing of captive insurance programs;~~ design and management of captive insurance programs

FINAL DESCRIPTION

captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services and market reviews; design and

management of captive insurance programs	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/kmz/
SIGNATORY'S NAME	Karl M. Zielaznicki, Esq.
SIGNATORY'S POSITION	Attorney of record, New York bar member
SIGNATORY'S PHONE NUMBER	212-704-6125
DATE SIGNED	04/21/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Apr 21 18:05:17 EDT 2014
TEAS STAMP	USPTO/RFR-72.242.197.1-20 140421180517918737-857320 59-50083b3b982db5540308da 133105c9963e82dcb1b991fb2 8e62e139f417813ad0-N/A-N/ A-20140421180229711859

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85732059** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has refused registration and issued a final rejection under Trademark Act Section 2(d), 15 USC §1052(d), claiming that Applicant's Mark A&M WOLVERINE ASSURANCE COMPANY for various "captive insurance services" in Class 36 so resembles the mark in US Trademark Registration No. 3239010 for the mark WOLVERINE INVESTMENTS in financial and investment services in Class 36, namely, "financial investment in the field of securities; financial management;

financial portfolio management; financial risk management; financial services in the nature of an investment security; investment advice; investment consultation; investment management; management of portfolios comprising securities” that it is likely to cause confusion, or to cause mistake, or to deceive. For the reasons set forth below, Applicant respectfully requests reconsideration of the Examiner’s finding that confusion is likely since the Examining Attorney has incorrectly ignored/applied incorrect weight to Applicant’s rebuttal evidence showing it is well known and recognized the cited mark “WOLVERINE” is weak and not entitled to a broad scope of protection in the insurance and/or financial services field. See McCarthy on Trademarks and Unfair Competition §11.85 (Rev. 2013); *In re Lucky Co.*, 209 USPQ 422 (evidence of third party use shows that the average purchaser has been so conditioned by the large number of users of similar marks that he will notice slight differences so that confusion in trade is not likely to arise from the contemporaneous use”).

The Examining Attorney has failed to adequately consider Applicant’s internet printout when accessing the strength of the cited mark. Evidence of third-party use falls under the sixth *du Pont* factor—the “number and nature of similar marks in use on similar goods.” *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Applicant contends that WOLVERINE is a very weak mark when considered in the light of the numerous third-party uses of similar marks on similar services and, therefore, registrant’s mark deserves only a limited scope of protection.

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WHB WOLVERINE ASSET MANAGEMENT INC (106020) View Summary: <ul style="list-style-type: none"> ▪ Investment Adviser Firm 	WOLVERINE INVESTMENTS	
WOLVERINE ASSET MANAGEMENT, LLC (138907) View Summary: <ul style="list-style-type: none"> ▪ Investment Adviser Firm 		801-72458
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WOLVERINE PARTNERS, LLC (144068) View Summary: <ul style="list-style-type: none"> ▪ Investment Adviser Firm (IA - Inactive)	MUTUALDECISION.COM	
WOLVERINE WEALTH ADVISORY SERVICES INC. (146564) View Summary: <ul style="list-style-type: none"> ▪ Investment Adviser Firm 		

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containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field”); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (“The record shows that a large number of marks embodying the words ‘bed and breakfast’ are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words ‘bed and breakfast’”).

In light of the above analysis, Applicant respectfully again submits that no likelihood of confusion exists between its Mark and the Cited Mark because: (1) the marks are different in their entireties, (2) the public and the marketplace have already determined that there is no likelihood of confusion in multiple registered investment advisors using the term WOLVERINE (including Registrant) in combination with descriptive terms offering identical services, (3) the services identified by the respective marks serve entirely different purposes and functions, (4) the consumers of the parties' services are sophisticated and/or are likely to exercise care when making the decision to purchase the parties' services, (5) the services of the parties are provided through different channels of trade, (6) the Cited Mark is not famous or well known but highly diluted in the registered investment advisor sector of the broad financial services field entitling it to a narrow scope of protection; (7) the cited mark is weak per the evidence submitted and not entitled to the broad scope of protection in the field of use. For the reasons discussed and the authorities relied upon herein, Applicant respectfully requests that the Examining Attorney reconsider the proffered arguments and evidence and approve Applicant's mark for registration.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 036 for captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; captive insurance consulting and services; design, management and auditing of captive insurance programs

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; ~~captive insurance consulting and services;~~ captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services and market reviews; ~~design, management and auditing of captive insurance programs;~~ design and management of captive insurance programs

Class 036 for captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services and market reviews; design and management of captive insurance programs

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)**Request for Reconsideration Signature**

Signature: /kmz/ Date: 04/21/2014

Signatory's Name: Karl M. Zielaznicki, Esq.

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 212-704-6125

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85732059

Internet Transmission Date: Mon Apr 21 18:05:17 EDT 2014

TEAS Stamp: USPTO/RFR-72.242.197.1-20140421180517918

737-85732059-50083b3b982db5540308da13310

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